

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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INTELLECTUAL VENTURES I LLC AND
INTELLECTUAL VENTURES II LLC

Plaintiff,

v.

HSBC USA INC. AND HSBC BANK USA,
NATIONAL ASSOCIATION,

Defendants.

1:13-cv-5386-WHP AJP

MEMO ENDORSED

**JOINT REPORT OF THE PARTIES PURSUANT
TO THE JULY 30, 2014 SCHEDULING ORDER OF THIS COURT**

The parties jointly submit this report pursuant to the July 30, 2014 Scheduling Order of this Court (Dkt. 60). For the reasons set forth below, the parties jointly request that the Court adjourn the conference scheduled for January 30, 2015, and stay this action for 6 months.

At a conference in this action on January 10, 2014, the parties and the Court agreed that it made sense to stay this action pending a decision of the Supreme Court of the United States in Alice Corporation Pty. Ltd. v. CLS Bank Int'l, No. 13-298. In response to the January 13, 2014, order of the Court (Dkt. 55) staying this action and directing the parties to submit a status report by June 30, 2014, the parties submitted a stipulation advising the Court that the Supreme Court had issued its opinion in Alice Corporation Pty. Ltd. v. CLS Bank Int'l on June 19, 2014 and requesting that the stay be continued pending the final resolution of two events which had arisen since the January 14, 2014 conference:

(1) The appeal filed May 13, 2014 in *Intellectual Ventures I LLC v. Capital One Financial, U.S. Court of Appeals for the Federal Circuit*, Case No. 14-1506, from the final judgment entered in Case No. 1:13cv740 in the Eastern District of Virginia, Alexandria Division, on April 22, 2014 (Doc. 376), and from the Order and Opinion granting summary judgment to Defendants in that action on April 16, 2014 (Doc. 371 & 372), and from all previous orders, rulings, findings, stipulations, and conclusions entered in that; and

(2) Final resolution of the last CBMPGR on any of the patents in suit, all of which are currently subject to CBMPGRs filed November 12, 2013 under CBM2014-0028 (PTAB) (Count 4 for infringement of U.S. Patent 8,083,137), CBM2014-0029 (PTAB), (Count 1 for infringement of U.S. Patent No. 7,664,701), CBM2014-0031 (PTAB), (Count 3 for infringement of U.S. Patent No. 6,182,894), CBM2014-0032 (PTAB), (Count 2 for infringement of U.S. Patent No. 7,603,382), and CBM2014-0033 (PTAB) (Count 5 for infringement of U.S. Patent No. 7,260,587). Note that Count 3 asserting of infringement of U.S. Patent No. 6,182,894 was previously dismissed by stipulation.

Pursuant to the Court's Scheduling Order dated July 10, 2014 (Dkt. 58), the parties filed a Joint Report on July 16, 2014 (Dkt. 59) stating that while the parties disagreed as to how Alice Corporation Pty. Ltd. v. CLS Bank Int'l would impact the validity of the patents in suit, the two events described above in paragraphs (1) and (2) that had arisen after the January 10, 2104 Status Conference created the need for a continued stay of this action. The parties jointly requested that the Court continue the

stay in this action and adjourn the conference scheduled for August 1, 2014 for about six months, which the Court did in its July 30, 2014 Scheduling Order (Dkt. 60).

The events that led the Court to stay the action for the last six months remain in place. The appeal described in paragraph (1) remains pending, and oral argument will be no earlier than March 2015. The CBMPGRs described in paragraph (2) remain pending before the Patent Trial and Appeal Board ("PTAB"). Accordingly, the parties jointly request that the Court adjourn the conference scheduled for January 30, 2015 and continue the stay in this action for an additional six months, at which time the parties will report on the status of the appeal and the pending CBMPGR proceedings.

Dated: January 16, 2015

DUNNEGAN & SCILEPPI LLC

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Application granted. The January 30, 2015 conference is adjourned and rescheduled for July 31, 2015. This action will remain stayed until that time.

SO ORDERED:

 1/23/15
WILLIAM H. PAULEY III U.S.D.J.